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IN THE
Supreme Court of the United States

OCTOBER TERM, 1975

NO. 75-1780

**METALLURGICAL EXOPRODUCTS
CORPORATION, Petitioner,**
v.
**PITTSBURGH METALS PURIFYING COMPANY,
INC., Respondent.**

**RESPONDENT'S BRIEF
OPPOSING CERTIORARI**

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**RESPONDENT'S BRIEF
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*To The Honorable Chief Justice and the Associate
Justices of the Supreme Court of the United States:*

Respondent, Pittsburgh Metals Purifying Company,
respectfully prays that the writ of certiorari requested
by petitioner be denied.

**COUNTER-STATEMENT OF QUESTIONS
PRESENTED FOR REVIEW**

1. Where old mechanical elements perform no additional or different function in a combination than they perform out of it and produce no new or synergistic result, are the standards of invention met?

2. Where the subjectmatter of a patent involves merely the ordinary use of a well known wedge and has been found "obvious" by the Courts below, would alleged commercial success make for patentability and overcome the Constitutional standards declared by this Court?

COUNTER-STATEMENT OF THE CASE

The patent in suit* (Petitioner's App.D, p.p. 19a-37a) covers nothing more than the use of a well known wedge to spread apart sideboards to hold them tightly against the inner walls of an ingot mold. Next to (or perhaps prior to) the wheel, a wedge is the oldest mechanical element devised by man, going back to the Stone Age. Yet, Petitioner wishes to patent it and withdraw it from the free use it has enjoyed over the centuries by those wishing to wedge elements apart.

The patent shows, in Fig. 3, (p. 19a) a wedge 52 and, in Fig. 2, (p. 21a) an equivalent spreading element, namely a spring 38. Both the spring and the wedge are guided by downwardly and inwardly tapered slots in the end face portions of end-adjacent sideboards. There is nothing unusual about a wedge being downwardly and inwardly tapered since they have been this way for centuries. As to guiding the edges of the wedging elements (spring or wedge) by slots, the District Court found that this had been done in the ingot mold sideboard art many years before the alleged conception date of the subjectmatter of the patent in suit. (Pet. App. p.p. 14a, 15a).

In fact, the District Court found that respondent had done it many years before the conception of the patent in suit when only two sideboards were used on the opposite longer sides, as shown in respondent's Tisdale patent (Figs. 10-11) (Pet. App. p. 14a). Later, when four sided sideboards became popular, and long before conception of the patent in suit, respondent's

*Note: All references hereafter are to Petitioner's Appendix.

employee, Helmer, used springs across the corners of the mold guided by downwardly extending slots on the faces of the sideboards near the ends, since the sideboards were relatively light (App. pp. 7a, 14a, 15a).

As heavier sideboards were used, petitioner resorted to the equivalent wedges which had been extensively used in the prior art across corners of the mold and guided by grooved surfaces on the end portions to spread the sideboards apart (App. p.p. 14a, 15a).

If there were any novelty or invention involved, it was first devised by respondent in the aforesaid Helmer's four wedging springs extending across four corners of the mold and guided by downwardly extending grooves on the faces of end-adjacent sideboards. To substitute mechanical equivalents, namely wedges for springs, is quite obvious to anyone skilled in the art. Respondent's Tisdale patent shows wedging turnbuckles (Fig. 9) and wedging springs/guided by grooves (Figs. 10-11) as mechanical equivalents. So does the patent in suit. While petitioner refers to "metal" wedges, it is significant that none of the claims in suit has such limitation (p.p. 11a, 12a).

There was no holding by the Courts below nor is it a fact that the wedges of the patent in suit did anything other than wedge, as wedges have always done. Petitioner "toots" the so called coaction between its grooves and wedges. This is nothing more than the well known wedging action with guiding grooves used many years prior to the Koch et al. patent by Tisdale, Helmer and others such as Alan Wood (App. p.p. 7a, 14a, 15a).

There was no finding by either the lower Court or Court of Appeals that the combination of old elements in the patent in suit performed any new, additional,

Counter-Statement of the Case.

different, unusual, unexpected or synergistic result in the combination than they performed out of it.

The District Court found to the contrary and held that the combination was "obvious" to those skilled in the art at the time the alleged invention was made, which finding was upheld by the Court of Appeals (Pet. App. p.p. 13a, 14a, 15a). Under such circumstances and in view of the recent decisions of this Court, the patent is invalid.

The lower Court further found petitioner's patent to have no presumption of validity in view of misrepresentations made to the Patent Office during prosecution of the patent in suit. The Court held (App. C, p. 15a) :

"The law is clear that no presumption of validity will be awarded to a patent where there is evidence that the Patent Office has been misled as to the true import of prior art references. *Kahn v. Dynamics Corporation of America*, 508 F.2d 939 (2nd Cir., 1975). It is the considered opinion of this Court that no presumption of validity shall be accorded to plaintiff's Koch et al. patent because plaintiff had misled the Patent Office as to the inoperability of the Witt patent. Likewise, the Patent Office was not informed at the time of considering plaintiff's application of the prior public uses of defendant testified to by Helmer and Tisdale and the prior public use of parallel grooves testified to by Rocher."

Actually, this Court has held such misrepresentations as invalidating the patent or making it unenforceable because of fraud, *Walker v. Food Machinery*, (1965) 383 U.S. 172.

Reasons For Denying the Writ.

REASONS FOR DENYING THE WRIT

I. The Patent in Suit Covers as Unpatentable Combination of Old Elements in View of This Court's Decisions.

About two months ago, this Court made a thorough review of its prior cases as applied to a combination of old mechanical elements in *Sakraida v. AG Pro, Inc.*, (1976) U.S.; Docket No. 75-110. The holdings by this Court in such case are completely dispositive of all issues raised by petitioner in the instant case.

This Court held (which is equally applicable to the instant case) :

We cannot agree that the combination of these old elements can properly be characterized as synergistic, that is, "result[ing] in an effect greater than the sum of the several effects taken separately." *Anderson's-Black Rock v. Pavement Co.*, 396 U. S. 57, 61 (1960). Rather, this patent simply arranges old elements with each performing the same function it had been known to perform, although perhaps producing a more striking result than in previous combinations. Such combinations are not patentable under standards appropriate for a combination patent. *A&P Tea Co. v. Supermarket, etc. Co.*, *supra*; *Anderson's-Black Rock v. Pavement Co.*, *supra*. Under those authorities this assembly of old elements falls under the head of "the work of the skillful mechanic, not that of the inventor." *Hotchkiss, v. Greenwood*, *supra*, at 267.

While sometimes a mechanical combination of elements may include those having dual functions with synergistic results, such is clearly not the case in the patent in suit. This Court defined "synergistic" in the

Sakraida case as "resulting in an effect greater than the sum of the several effects taken separately".

II. Alleged Commercial Success, Without Invention, Will Not Make Patentability.

Many ideas that are not new or patentable have enjoyed commercial success. Typical are products sold through franchises or otherwise enjoying the benefit of extensive advertising, marketing or sales effort. Therefore, filling a long felt want or commercial success cannot be a primary criterion for determining patentability, as proposed by petitioners. This Court commented on this matter in the A & P case by stating: (p. 154)

"The Court of Appeals and the respondent both lean heavily on evidence that this device filled a long-felt want and has enjoyed commercial success. But commercial success without invention will not make patentability. *Toledo Pressed Steel Co. v. Standard Parts, Inc., supra.*"

* * *

"To bring these devices together and apply them to save the time of customer and checker was a good idea, but scores of progressive ideas in business are not patentable, and we conclude on the findings below that this one was not."

This Court went on to say that the difference over the prior art did not meet the Constitutional standards of invention. This Court held (p.p. 153-154)

"We set aside no finding of fact as to invention, for none has been made except as to the extension of the counter, which cannot stand as a matter of law. The defect that we find in this judgment is that a

standard of invention appears to have been used that is less exacting than that required where a combination is made up entirely of old components."

* * *

"It is worth emphasis that every patent case involving validity presents a question which requires reference to a standard written into the Constitution."

It is clearly established law that commercial success, alone, does not establish patentability, as brought out by this Court in *Graham v. John Deere Co.*, (1966) 383 U.S. 1, and forcefully emphasized in *Anderson's Black Rock v. Pavement Salvage Co.*, 396 U.S. 57; 163 U.S.P.Q. 673 at 674, wherein this Court held:

"The convenience of putting the burner together with the other elements in one machine, though perhaps a matter of great convenience, did not produce a "new or different function," *Lincoln Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549, 37 U.S.P.Q. 1, 3, within the test of validity of combination patents.

"A combination of elements may result in an effect greater than the sum of the several effects taken separately. No such synergistic result is argued here. It is, however, fervently argued that the combination filled a long felt want and has enjoyed commercial success. But those matters 'without invention will not make patentability.' *A & P Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 153, 87 U.S.P.Q. 303, 306."

The Supreme Court then concluded at 675:

"We conclude further that to those skilled in the art the use of the old elements in combination was not an invention by the obvious-nonobvious stand-

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ard. Use of the radiant burner in this important field marked as successful venture. But as noted, more than that is needed for invention. Reversed."

Petitioner quotes many fragmented parts of the decision of the lower Court out of context, tying them together in a manner which is apt to mislead this Court as to what was actually said by the lower Court. For example, on page 5 of Petitioner's brief, first paragraph states:

"The District Court characterized the floating problem as "basic" and found that the patent in suit "solved problems that were 'basic' in the sense that they had persisted for a long time and thus seemed to be inherent in the process of steelmaking" (App. C, p. 15a).

Actually, as will appear on page 15a, the District Court merely said that the patent solved "problems" (in the plural) that were basic etc. without identifying what the problems were. Petitioner conveniently omitted the last part of the sentence wherein the Court held that plaintiff's alleged invention "was merely an obvious combination of old elements".

Therefore, resort to the specific wording of the decision of the District Court is respectfully urged. Practically the only evidence presented by petitioner in an effort to prove commercial success is the self-serving oral testimony of Rocher unsupported by documentary evidence. A close look at such evidence shows many flaws.

In any event, commercial success or filling a long felt need, without invention, does not make for patentability, as held by the A & P, Black-Rock, Graham v. Deere and Sakraida cases, cited above.

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In the most recent, above-cited Sakraida case, this Court held as follows:

"Though doubtless a matter of great convenience, producing a desired result in a cheaper and faster way, and enjoying commercial success, Dairy Establishment "did not produce a 'new or different function' . . . within the test of validity of combination patents." *Anderson's-Black Rock v. Pavement Co.*, supra, at 60. These desirable benefits "without invention will not make patentability." *A & P Tea Co. v. Supermarket, etc. Co.*, supra, at 153. See *Dann v. Johnston*, supra."

It is also clear from the above cited A & P, Black-Rock, Graham and Sakraida decisions of this Court that commercial success and filling a long felt need are *secondary* considerations. As held by *Graham v. John Deere*, (pp. 17, 18) concerning 35 U.S.C. 103:

"Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy."

The above is a clear statement of the law.

Petitioner's assertions that such secondary considerations may be overlooked or that they should be primary in importance are deemed to be without merit. In the instant case, the lower Court held: (App. C-15a, 16a)

"While such secondary considerations as commercial success and long-felt but unresolved needs

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in the field constitute relevant evidence in a close case on the issues of obviousness, once it is established by prior art references that the difference between the patents in suit and the prior art is not substantial enough to be termed invention, the patent cannot be sustained. Combinations of old elements may be patentable, but such is not the case here."

No case cited by petitioner indicates that commercial success has been denied secondary consideration in the finding of obviousness as provided by Graham. There is clearly no conflict among the Courts on this question.

Petitioner complains because commercial success is given only "secondary" consideration by Graham, urging that it should be given *primary* consideration or, in fact, it should be determinative of invention. The above cited decisions of this Court indicate otherwise.

Petitioner urges that the Graham case requires specific findings of fact as to the level of mechanical skill in a particular art. No such requirement is found in the Graham case as held by the Court of Appeals in the instant case. (App. A, 6a, footnote 8) To make numerous specific findings on the level of mechanical skill in a particular art would be a far reaching, very extensive, burdensome and fruitless undertaking. The lower Court in the instant case clearly considered evidence on this matter as well as that on prior art and differences over the prior art, as clearly set forth in its decision. (Pet. App. pp. 14a, 15a).

Conclusion.

CONCLUSION

For the above reasons, it is respectfully urged that the writ should not be granted.

Respectfully submitted,

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